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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jonathan R. Iverson

Serial No. 76262553

Richard John Bartz of Bartz & Bartz, P.A. for Jonathan R. Iverson.

Alicia P. Collins, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On May 29, 2001, applicant filed the above-identified application to register the mark SCUBA SYSTEMS on the Principal Register for "scuba equipment, namely, masks, fins, buoyancy vests, air regulators, breathing equipment and travel bags." The application was based on applicant's claim of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground

that applicant's mark is generic for the identified goods. In particular, the Examining Attorney stated that SCUBA SYSTEMS identifies "the genus (category or class) of the applicant's goods." First Office action, p. 2. In support of the refusal, the Examining Attorney submitted definitions of "scuba diving" as "the sport of swimming under water with special breathing equipment"¹ and "system" as "[a] group of interacting, interrelated, or interdependent elements forming a complex whole."² In addition, the Examining Attorney submitted excerpts of articles from the NEXIS database that refer to "scuba system(s)." The following are examples:

The complete scuba system consists of a regulator system (pressure and depth gauges, compass), buoyancy compensator (a vest that attaches to the tank) for ...
(Montgomery Advertiser, July 26, 1992);

This is one of those "Why didn't I think of that?" ideas. The new SWEM system from Aquavit, Inc. is a compact scuba system for shallow-water use.
(Trailer Boats, December 1, 2000);

... the Academy will conduct additional breathing apparatus testing, such as mixing helium and oxygen in an open circuit scuba system for deep depths, he said.
(Navy News and Undersea Technology, January 31, 2000); and

¹ Cambridge Dictionaries Online, Cambridge International Dictionary of English, 2000 (electronic version).

² The American Heritage Dictionary of the English Language (3d ed. 1992)(electronic version).

... there will be seminars and demonstrations on technical diving, nitrox, trimix, or rebreathers. You can learn all about these advanced scuba systems.
(Skin Diver, September, 1998).

Also, the Examining Attorney held the identification of goods unacceptable because it included goods in more than one class.

Applicant, in response to this Office action, argued against the refusal to register, maintaining that his mark is only suggestive. Applicant submitted an excerpt from Webster's New Ninth Collegiate Dictionary defining "scuba" as "an apparatus used for breathing while swimming underwater." Also, applicant amended his identification of goods to "scuba equipment, namely, masks, fins, and travel bags."

The Examining Attorney accepted the amendment to the identification of goods, but was not persuaded by applicant's argument on the issue of genericness. The refusal on this basis was continued. The Examining Attorney stated that the nature of the goods was not clear and requested that applicant submit samples of advertisements and promotional materials for goods of the same type.

In his response, applicant again argued against the genericness refusal. Applicant submitted printouts of pages from the website DiversDiscount.com which shows masks, fins and backpacks that may be ordered from the website.

The Examining Attorney issued a final refusal to register the mark on the ground that SCUBA SYSTEMS is merely descriptive of "scuba equipment, namely, masks, fins, and travel bags."³ It is the Examining Attorney's position that the individual terms "scuba" and "system" are descriptive of applicant's identified goods and that the composite term SCUBA SYSTEMS is equally descriptive. The Examining Attorney argues that the mark SCUBA SYSTEMS "immediately tells the consumer that applicant's goods are components of scuba systems." Final Office action, p. 2. With the final Office action, the Examining Attorney submitted printouts from websites of companies that sell diving equipment. According to the Examining Attorney, this evidence "illustrates that masks, fins, and travel bags are generally used in conjunction with scuba breathing apparatus (e.g. regulator, octopus, BCD, tank, gauge) for the purpose of scuba diving. The goods identified in the

³ The Examining Attorney withdrew the refusal based on genericness.

application are part of an interrelated and interdependent group of equipment used for scuba diving." Final Office action, page 2.

Applicant filed a notice of appeal, which was timely followed by applicant's appeal brief. The Examining Attorney filed a brief and applicant filed a reply brief. An oral hearing was not requested.

Applicant contends that its mark is at most suggestive. According to applicant, the individual terms comprising its mark are not descriptive, that is, the term scuba is not descriptive of masks, fins or travel bags because none of these items are used for breathing, and the word systems is not descriptive of the goods because there is no connection between the word systems and such goods. Also, applicant points out that the identified goods may be used by water enthusiasts other than scuba divers such as snorkelers, cave divers and float tubers.

The only issue on appeal is whether SCUBA SYSTEMS is merely descriptive of the identified goods. It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature,

function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather it is sufficient if the phrase describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applicant's goods, as amended, are "scuba equipment, namely masks, fins and travel bags." Although masks and fins are not underwater breathing apparatus, they clearly are items, as shown by the record, that are used when scuba diving.

When the mark SCUBA SYSTEMS is considered in relation to masks and fins, it immediately informs prospective purchasers that the identified goods are components of systems for swimming under water, i.e., scuba diving

systems. See, e.g., *Remington Products Inc. v. North American Philips Corp.*, 892 F.2d 1576, 3 USPQ2d 1444, 1448 (Fed. Cir. 1990)[omission of the word "PERSONAL" from the phrase "TRAVEL CARE" does not obviate descriptiveness of such phrase for personal travel care products].

We recognize that masks and fins may also be used in other water activities. However, as previously noted, it is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof.

Further, the fact that travel bags may not be thought of as components of scuba diving systems, since they are not actually used when swimming under water, does not mean the mark is not merely descriptive. In order for a term to be merely descriptive, it does not have to describe all goods or services that are included within applicant's identification of goods or services. In *re Analog Devices*, 6 USPQ2d 1808 (TTAB 1988), aff'd, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

Decision: The refusal to register is affirmed.